

Art Unit: 1622

Claims 1-5, 12-14, 24, 29, 45, 68, 101-102, 110-112, are pending in this application.

Claims 6-11, 15-23, 25-28, 30-44, 46-67, 69-100, 103-109, 113, are deleted.

## **DETAILED ACTION**

### ***Election/Restriction***

Claims 1-5, 12-14, 24, 29, 45, 68, 101-102, 110-112, are drawn to more than one inventive concept (as defined by PCT Rule 13) and, accordingly, a restriction is required according to the provision of PCT Rule 13.2.

PCT Rule 13.1 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention).

PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex B, Part 1(b), provides that "special technical features" mean those technical features which, as a whole, define a contribution over the prior art (novelty and/or unobviousness).

I. Claims 1-5, 12-14, drawn to compounds and compositions thereof, wherein R1 is cyclohexyl, R2 is OH, R3 is phenyl, X is S or O, and Y is S or O, classifiable in various classes, and numerous subclasses. Further restriction may be required.

II. Claims 1-5, 12-14, drawn to compounds and compositions thereof, wherein R1 is cyclohexyl, R2 is OH, R3 is phenyl, X is S or O, and Y is NH, classifiable in various classes, and numerous subclasses. Further restriction may be required.

III. Claims 1-5, 12-14, drawn to compounds and compositions thereof, wherein R1 is cyclohexyl, R2 is OH, R3 is phenyl, X is NH, and Y is NH, classifiable in various classes, and numerous subclasses. Further restriction may be required.

Art Unit: 1622

IV. Claims 1-5, 12-14, drawn to compounds and compositions thereof, wherein R1 is cyclohexyl, R2 is OH, R3 is phenyl, X is NH, and Y is S or O, classifiable in various classes, and numerous subclasses. Further restriction may be required.

V. Claims 1-5, 12-14, drawn to compounds and compositions thereof, wherein the compounds are not in groups I to IV above. Further restriction may be required.

VI. Claims 24, 29, 45, 68, drawn to methods of using compounds of groups I-V, classifiable in various classes, and numerous subclasses. Election of one of groups I-V is required. Further restriction may be required.

VII. Claims 101-102, drawn to assay for testing compounds, wherein the compounds are not known. Not classifiable. Further restriction may be required when compounds are disclosed to the Office. Otherwise, applicant must elect one of groups I-V above.

VIII. Claims 110-112, drawn to kit comprising compounds, wherein the compounds are not known. Not classifiable. Further restriction may be required when compounds are disclosed to the Office. Otherwise, applicant must elect one of groups I-V above.

1. In the instant inventions, the only structural element shared by groups I-VIII is  $-C=C-C=C-C(O)-$ . However,  $-C=C-C=C-C(O)-$  is well-known in the art. See D1-D4 in the ISR of PCT/US04/043950. Therefore, under PCT Rules 13.1 and 13.2,  $-C=C-C=C-C(O)-$  does not constitute a special technical feature among the groups.

### ***Selection of a Species***

3. In an election of any of Groups I-VIII a provisional election of a single compound is further required including an exact definition of each substitution on the base molecule (Formula #), wherein a single member at each substituent group or moiety is selected. For example, if a base molecule has a substituent group R1, wherein R1 is recited to be any one of H, OH, COOH, aryl, alkoxy, halogen, amino, etc., then applicant must select a single substituent of R1, for example OH or aryl, and each subsequent variable position.

In the instant case, Applicant must elect one representative for each variable (substituent) in formula I, and the point of attachment of each elected substituent must be specified. The elected substituents must be specific not generic so as to define a species, and the species must be disclosed in the specification. Part of the species corresponding to each substituent in the elected formula must be identified, and its structure must be submitted.

Examination will then proceed on the elected species. Per MPEP 803.02, if the elected species is found unpatentable, the provisional election will be given effect and all other claimed species will be withdrawn from consideration. If the elected species is found allowable, the search will be expanded by the Examiner to other species and subgeneric compounds within the elected group until:

I. A prior art is found.

Art Unit: 1622

II. Compounds of the elected invention are found to lack unity of invention. See above.

III. All the compounds of the elected group are searched "if the members are sufficiently few in numbers" or "to the extent necessary to determine patentability." "The prior art search will not be extended unnecessarily to cover all nonelected species." MPEP 803.02.

In accordance with the decisions in *In re Weber*, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 198 USPQ 334 (CCPA, 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter lacks unity of invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Art Unit: 1622

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the examiner before the patent issues withdraws the restriction requirement. See MPEP § 804.01.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Kosar, can be reached on (571) 272-0913. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, Art Unit 1622

July 13, 2011

Application/Control Number: 10/585,216

Page 6

Art Unit: 1622